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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/839,161	04/22/97	NEWTON	W

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EXAMINER

COHEN, C

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 08/07/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/839,161

Applicant(s)  
Newton et al

Examiner  
Curtis Cohen

Group Art Unit  
3623



☒ Responsive to communication(s) filed on Apr 22, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-90 is/are pending in the application.

Of the above, claim(s) 26-28 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-25 and 29-90 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Apr 22, 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7/14/97

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-25 and 29-90, drawn to the apparatus, classified in class 49, subclass 446.
  - II. Claims 26-28, drawn to method of using the window, classified in class 49, subclass 506.
2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using such as removing the shoe hooks from the frame by holding the window in place and first pulling down and then pulling outward in a direction perpendicular to the channel on the shoe hook, then pulling the window out from the frame.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Eugene Stephens on July 28, 1998 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-25 and 29-90. of this election must be made by applicant in replying to this Office action. Claims 26-28 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tool, as claimed in claims 33 and 63 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-11, 13-15, 24, 25, 29-38, 48-51, 53-60, 70-73, 76-78, 82-84, 87-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the independent

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claim 1, applicants claim the subcombination of a support system and functionally recite a sash and window jambs. This is not a problem as long as applicants refers to the sash and jambs functionally throughout the claims. In lines 4-5, applicants recite arms mounted on the stiles of the sash. By mounting a positively claimed structure, the arms, to the functionally recited sash leads one to believe that it is applicants' intent to claim the combination of the sash and support system. This is in contradiction to the preamble of the claim which clearly indicates that only the subcombination of the support system is being claimed. Therefore, it is indefinite whether or not applicant is claiming the subcombination support system or the combination of the support system and the jamb/sash. Applicants are required to clarify this ambiguity by either functionally reciting the sash or by positively claiming the combination in the preamble of the claim. It is assumed for the purposes of examination that applicants are claiming the subcombination. Similar problems occurring throughout the claims are indicated by claim and line number. Claim 61, lines 1 and 4 ("shoes" are being functionally recited in the preamble); Claim 67, the preamble again indicates the shoes and sashes are being functionally recited where the body of the claim indicates that they are positively claimed. Is applicant claiming shoes and sashes in combination with the support system?

Claim 3, line 1, it is not understood as to what structure applicant is referring when reciting "counterbalance lifts." For the purpose of examination, it is assumed that applicants are referring to the force applied to the counterbalance shoes.

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Claims 6-11, 13, 31, 37, 49-51, 57, 58, 60, 70, 71, 73, 76, 77, 78, 82, 83, 84, 87-89, it is unclear how the process of cutting or configuring the metal extrusions, which is not given patentable weight, to a certain size has to do with the final claimed product. How does this further limit the structure as it used in the final assembly. Further, one of ordinary skill would have known to make the shoe width to fit the channel in which it is received otherwise the invention would not work.

Claims 29 and 38, it is not understood as to what "shoe width" applicants are referring. Is this a generic, dimensionless shoe width or is there a particular standard width that is common in many window assemblies? Applicants must set forth a dimension from which the "shoe width" is measured. Without any point of reference, it is indefinite regarding the size of the shoe width.

Claims 30 and 43, applicants have not set forth a means to provide the hook deployment. This renders the claim incomplete and indefinite.

Claim 35, there is no antecedent basis for "the interconnected region."

Claim 48, applicants have not set forth a means to provide the bracing of the sash support arm which renders the claim indefinite.

Claim 53, lines 5 & 6, it appears as though applicants need a verb such as --having-- between "and" and "end" because the claim does not make grammatical sense.

Claim 55, line 3, this claim is indefinite because applicants recite the sash to be lifted from the window. It appears that it is applicants' intent to recite a "window frame" not just a window.

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Claim 60, along with the combination/subcombination indefiniteness as stated above, applicants are claiming a product by process which is given little patentable weight. The hooks in one position engage the jamb and in another position do not engage the jamb. This is a process of using the positively claimed structure of a hook. If the prior art teaches the claimed structure, then the structure is considered as being capable of performing such a process.

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4, 7, 12-16, 19-21, 53-58, 60, 67, 68, 69, 74, 75, 79-81, 85, 86 and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten, Sr. #2,987,758. Osten, Sr. teaches a movable sash 20 mounted in a window frame 12 having sash guides 14. Sash support arms 50 are pivotally mounted on a pivot 44 between a outwardly and a downwardly extending position. The arms 50 rest on a pair of sash shoes 92 as best shown in Figure 1. In the inwardly extending position, the arms can touch an outer region of the shoe, and in the outwardly extending position the arms can touch the inner region of the shoe. A counterbalance is applied to a hook region which is above the outer platform region of the shoe. A locking element is taught by the surface 102. In column 2, lines 1-6, Osten, Sr. discloses that it is known to use extrusion as a manufacturing technique. Claim 12, the preamble of this claim indicates a Jepson type claim

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where the structure indicated in the preamble of the claim is admitted prior art. Therefore, the burden of the examiner is to provide evidence of the subcombination of the structure listed in sections a-c of claim 12. However, Osten, Sr. meets the requirements for a 102(b) by teaching all of the limitations in the preamble and the limitations in sections a-c. The shoe of Osten, Sr. also comprises a guide 110 which guides the shoe and window along a track 114. A retaining groove is taught by the eyelet of hook 84.

11. Claims 29, 30, 32-34, 39-44, 46-48, and 61-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Haas. Haas teaches that it is known in the art to provide a pivotally mounted locking means 92 mounted on a pin in a pin groove (or slot) on a sash shoe 65 which is adapted to lockingly engage the partition walls, see column 3, lines 15-22. A spring latch 70 retains the hook in an undeployed position and it is capable of being manually moved or moved with a tool. A guide 64 is mounted on the shoe 65.

12. Claims 8-10, 17, 18, 22-25, 70, 71, 73, 76, 77, 78, 82-84, and 87-89 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Osten, Sr. Considering the Section 112(2nd) rejection above, Osten, Sr. teaches the invention as discussed in the rejection above. Osten, Sr. does not disclose to what particular dimension the metal is intended to be sized. However, applicants' claims do not define a particular structural feature that would distinguish from Osten, Sr. ~~and Haas~~. Therefore, it is inherent that one of

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ordinary skill would make shoes and the arms to fit whatever size window for which they are installed.

13. Claims 31, 49-51, 64-66 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haas. Considering the Section 112(2nd) rejection above, Haas teaches the invention as discussed in the rejection above. Haas does not disclose the particular function of what size the metal is intended to be sized. However, it is inherent that one of ordinary skill would make shoes and the arms to fit whatever size window for which they are installed.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten, Sr. as applied to claims 1-4 above and in further view of Haas #2,791,795. Osten, Sr. discloses the claimed invention as discussed in the rejection above. Osten, Sr. does not disclose a locking elements being pivotally mounted on the shoes. Haas teaches that it is known in the art to provide a pivotally mounted locking means 92 on a sash shoe which is adapted to lockingly engage the

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partition walls, see column 3, lines 15-22. A spring is provided to bias the locking means in an undeployed position. For this reason, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Osten, Sr. with a pivotally mounted locking member as taught by Haas.

16. Claims 35-38, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas in view of Osten, Sr. Haas discloses the invention as taught in the Section 102 rejection above including a locking slot 96. Haas does not disclose the shoe 64 being formed of a resin material. Osten, Sr. teaches that it is known in the art to form a shoe guide 110 out of a resin material as described on column 3, lines 45-49, to reduce the frictional noise created by the known metal guides when they contact the metal channels. For this reason, it would have been obvious to one having ordinary skill in the art at the time of applicants' invention, to provide Haas with a guide formed from a resin material as taught by Osten, Sr.

17. Claims 11, 59, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten, Sr. Osten, Sr. teaches the invention as discussed in the Section 102(b) rejection above. Osten, Sr. lacks a support arm having extruded coding lines indicating the length of the support arm. Coding symbols are well known in the art of manufacturing. One example of this teaching is on the head of a bolt which has different coding lines indicating the different strengths of each

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bolt. Therefore, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Osten, Sr. with code lines to indicate the length of the arm.

18. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haas. Haas teaches the invention as discussed in the Section 102(b)/103 rejection above. Haas lacks a support arm having extruded coding lines indicating the length of the support arm. Coding symbols are well known in the art of manufacturing. One example of this teaching is on the head of a bolt which has different coding lines indicating the different strengths of each bolt. Therefore, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Haas with code lines to indicate the length of the arm.

### *Conclusion*

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Perry '978 pivotable shoe; Trout '819 pivotable shoe; Weidner '795 support arm; Johnson '511 support arm; Scott '434 locking shoe; Gaines et al '543 pivotable arm; Holly '438 pivotable arm; Weidner et al '236 hook means 54; Westfall '838 pivoting locking mechanism; Love '559 shoe and arm combination; Barney '146 arm G; Muir et al '906 locking means Q; Erickson et al '212 locking shoe; Westfall et al '871 locking shoes; Haas '630 locking shoe with support arm.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen

August 3, 1998

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large, looped initial 'D'.

**Daniel P. Stodola**  
**Supervisory Patent Examiner**  
**Group 3600**